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EXAMINER	
ANGEBRANNDT, MARTIN J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEN HARRIS

Appeal 2010-002411
Application 09/692,075
Technology Center 1700

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 26, 28, 32-36, 43, and 44. The subject matter of claims 29 and 37-42 has been indicated as containing allowable subject matter. (Final Rejection 1; App, Br. 1). We have jurisdiction under 35 U.S.C. § 6(b).[2]

The Invention

Appellant's invention is directed to a method of transferring data from a holographic master to another surface. Claims 26 and 28 are illustrative:

> 26. A method of transferring data from a holographic master to another surface via a seamless transfer medium comprising a polyimide material, the method comprising the steps of
>
> (a) providing the seamless transfer medium by casting the polyimide material on the holographic master containing the data so that an impression of diffraction gratings of the holographic master is made on the cast polyimide material;
>
> (b) removing the seamless transfer medium with the impression of the diffraction gratings from the holographic master;
>
> (c) heat curing the seamless transfer medium; and
>
> (d) using the seamless transfer medium to emboss the data to another surface.

[2] In rendering this decision we have considered the Appellant's submissions filed on July 6, 2005, and June 13, 2007. We have also considered the Examiner's position as set forth in the Examiner's Answer dated September 15, 2008.

28. A method of embossing data from a seamless embossing surface to another surface, said method comprising the steps of:

(a) spin coating a photodefinable polyimide material on a roller and heat precuring the polyimide material to form said seamless embossing surface of a target thickness;

(b) cooling said seamless embossing surface to ambient temperature;

(c) profiling said seamless embossing surface by two interfering laser beams to form diffraction patterns to define said data on said seamless embossing surface;

(d) wet developing said data on said seamless embossing surface by using a solution;

(e) heat curing of the seamless embossing surface; and

(f) embossing said another surface with said data by said seamless embossing surface.

The Examiner relies on the following references in rejecting the appealed subject matter:

Sassmannshausen et al.	5,104,768	Apr. 14, 1992
Shvartsman	5,279,689	Jan. 18, 1994
Hino et al.	5,374,469	Dec. 20, 1994
Abraham	5,452,282	Sept. 19, 1995
McGrew	5,521,030	May 28, 1996
Hagen et al.	6,010,825	Jan. 4, 2000
Kataoka et al.	JP 08-039572	Feb. 13, 1996
Fan et al.	EP 0766142 A1	Feb. 4, 1997

Thermally Induced Surface Relief Holograms, 30 IBM TECHNICAL DISCLOSURE BULLETIN 1392 (1987). (herein after IBM)

Claim 26 stands rejected under 35 U.S.C. § 103(a) as unpatentable over IBM, in view of Shvartsman and Kataoka.

Claims 28, 33, 35, and 43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sassmannshausen in view of IBM, Shvartsman, Kataoka, Fan and McGrew.

Claims 28, 32, 33, 35, and 43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sassmannshausen in view of IBM, Shvartsman, Kataoka, Fan, McGrew and Abraham.

Claims 28, 33-36, 43, and 44 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sassmannshausen in view of IBM, Shvartsman, Kataoka, Fan, and McGrew, and further in view of Hino and/or Hagan.

OPINION

The dispositive issue for the rejection on appeal is the following:

Did the Examiner err in determining that the combination of IBM, Shvartsman, and Fan as well as the other cited references renders the subject matter of independent claims 26, 28, and 43 obvious under § 103?

After thorough review of the respective positions provided by Appellant and the Examiner, we agree with Appellant that the combination of cited references does not render the subject matter of independent claims 26, 28, and 43 obvious within the meaning of § 103.

As to claim 26, Appellant argues that IBM does not teach the holographic master transferring the already existing holographic diffraction grating onto a casted polyimide and neither Shvartsman nor Kataoka disclose casting a polyimide material onto a holographic master. Thus,

Appellant concluded that the combination of IBM, Shvartsman and Kataoka does not describe or suggest all the elements of claim 26. (Reply Br. 2-3).

As to claims 28 and 43, Appellant argues that the goal of IBM is to eliminate the web development processing; Shvartsman is directed to stamp-embossing processes; and Fan relates to photopolymerized thermoplastic materials which are different from the photodefinable polyimide required by the claimed invention. Appellant argues that the combination of IBM, Shvartsman, and Fan as well as the other cited references provides the utilization of different materials and different methods, including some which would not be combinable with one another. (Reply Br. 4-7). Thus, Appellant concluded that the combination of IBM, Shvartsman and Fan as well as the other cited references do not provide a suggestion of the combination necessary to render the claimed subject matter obvious and the Examiner has not provided an adequate explanation as to why a person of ordinary skill in the art would have made the selections necessary to render the claimed invention obvious. (*Id.*).

The Examiner's responses to Appellant's arguments have been fully considered but are not persuasive. The Examiner's citation to the various prior art references as well as the analysis provided in the Examiner's Answer are insufficient to establish obviousness within the meaning of § 103.

During examination, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn,* 441 F.3d 977, 988 (Fed. Cir. 2006)). "[T]he analysis that 'should be made explicit' refers not to the teachings in the prior art of a motivation to combine, but to the court's analysis." *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009).

For the foregoing reasons we reverse the Examiner's stated rejections.

DECISION

The 35 U.S.C. § 103 rejections of claims 26, 28, 32-36, 43, and 44 are reversed.

REVERSED

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